

PRE-APPEAL BRIEF REQUEST FOR REVIEW Mail Stop AF	Application Number	10/516,621
	Filing Date	December 3, 2004
	First Named Inventor	Tatsuo TSUNEKA
	Group Art Unit	1713
	Examiner Name	William K. Cheung
	Attorney Docket No.	SAE-036

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Applicant(s) request(s) review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.


The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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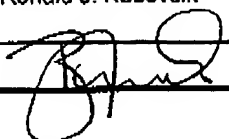
- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
- ☒ attorney of agent of record.
- ☐ attorney of agent acting under 37 CFR 1.34.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

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Signature		Date	April 6, 2007

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Name (Print/Type)	Ronald J. Kubovcik		
Signature		Date	April 6, 2007

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 10/516,621 Confirmation No. 5295
Applicant : Tatsuo TSUNEKA et al.
Filed : December 3, 2004
TC/A.U. : 1713
Examiner : William K. Cheung
Dkt. No. : SAE-036
Cust. No. : 20374

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Ronald J. Kubovcik

REMARKS ACCOMPANYING
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

April 6, 2007

Sir:

This paper includes remarks in support of a Pre-appeal Brief Request for Review. A Notice of Appeal from the decision dated November 8, 2006, of the primary Examiner finally rejecting claims 6 to 11 is being filed concurrently herewith.

Claims 6 to 11 stand rejected as being obvious over Ashihara et al. (U.S. Patent No. 6,277,912; hereinafter "Ashihara") in view

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REMARKS ACCOMPANYING
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PATENT

of Verardi et al. (U.S. Patent No. 5,863,646; hereinafter "Verardi"). The rejection is set forth in paragraph 5 of the office action of August 9, 2005.

Applicants respectfully submit that the rejection is improper because, contrary to the allegation of the Office, Verardi does not teach the functional equivalence of an aromatic solvent and an ethereal solvent in a process for preparing an aqueous resin dispersion composition as disclosed in Ashihara. The Office cites col. 6, lines 42-44 and 50-55, of Verardi as teaching such an equivalence. However, this section of Verardi is directed to solvent-based, not aqueous-based, compositions. Refer to the section (1), "VERARDI DOES NOT TEACH THAT AN AROMATIC SOLVENT AND AN ETHEREAL SOLVENT ARE FUNCTIONALLY EQUIVALENT IN A PROCESS FOR PREPARING AN AQUEOUS RESIN DISPERSION COMPOSITION AS DISCLOSED IN ASHIHARA", beginning on page 2, line 8, of the response filed February 8, 2007.

Notwithstanding the above impropriety of the rejection, applicants submitted comparative data in the form of a Declaration under 37 C.F.R. 1.132 by Tatsuo TSUNEKA on May 22, 2006, which rebuts any *prima facie* case of obviousness. However, the Office refuses to give full weight to the comparative data on the basis

that it does not provide a comparison with the cited prior art. The Office's position regarding consideration of the comparative data is set forth in paragraph 5 of the office action of July 25, 2006, and the paragraph bridging pages 5 and 6 of the office action of November 8, 2006.

The Office's refusal to consider the comparative data is improper. The comparative data provides a comparison with prior art that is closer to the claimed invention than the cited art. As explained in section (2), "THE CLOSEST PRIOR ART IS NOT REQUIRED TO BE PRIOR ART CITED BY THE OFFICE", and section (3), "COMPARATIVE EXPERIMENT 2 OF THE DECLARATION (UNDER 37 C.F.R. § 1.132) OF TATSUO TSUNOKA DATED MAY 9, 2006, PROVIDES A PROPER COMPARISON WITH THE PROCESS OF ASHIHARA", on pages 3 to 7 of the response filed February 8, 2007, the comparative data provides a comparison with a process which differs only in the sequence of steps recited in claim 6 of the present application and also provides a proper comparison with the process of Ashihara.

In view of the foregoing arguments, appellant respectfully requests that the panel allow the application on the existing claims.

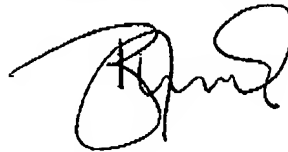
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Please charge any required fees or credit any overpayment to
our Deposit Account No. 111833.

Respectfully submitted,

KUBOVCIK & KUBOVCIK



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